

## REMARKS

This Amendment is in response to the Office Action of May 23, 1994. Applicant has canceled claims 12-14 pertaining to the non-elected method and has amended independent claims 1 and 7 by including the structural limitation of claim 5 and identifying the primary purpose (but not sole possible purpose) of the removable single-walled panel member. As a result, the single-walled panel member is more distinctly claimed. Furthermore, Applicant has amended dependent claims 3, 4, 6 and 8 to assist in distinguishing the present invention from the cited art references and has added claims 15 and 16, wherein claim 15 is a limitation from original claim 8 and claim 16 is a new independent claim.

Claims 1-5 and 7 were rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 4,779,725 to Gerber. Gerber discloses a golf bag uniquely constructed for compact storage. The golf bag includes a thin rectangular construction enabling a pair of these golf bags to be compactly nested together by stacking the golf bags horizontally in reverse direction (See Col. 5, lines 5-8). In order to facilitate packing of golfing clothing as discussed in Col. 3, lines 43-46, the dual-walled pockets may be removed from the golf bag. More specifically, each of these dual-walled pockets includes a front member (first wall) and a rear member (second wall) joined together by side panels and a zipper (See Col. 5, lines 20-22). The zipper extends about three edges of the pocket allowing the pocket to be opened in notebook fashion but not removed (See Col. 5, lines 22-25). Rather, a number of fasteners, appearing to be flat-head screws which are inserted through the rear member of the pocket into a front side of the body portion of the golf bag, must be extracted before the pocket can be removed (See Col. 5, lines 29-38).

Applicants' golf bag, as now claimed in independent claims 1 and 7, is constructed in a manner neither taught or suggested by Gerber. Applicants' golf bag employs a single-walled panel member removably coupled to a first longitudinal side of the golf bag. This single-walled panel member may operate as a conventional pocket when at least partially coupled to the golf bag, but more importantly, it may be completely removed from the golf bag to allow machines to sew and/or embroider indicia thereto for personalizing one's golf bag. Dual-walled pockets, however, still require hand sewing and/or embroidery which is difficult and costly to perform.

It is clear that this problem was unrecognized and unsolved by Gerber. In fact, as discussed in the Background Section of Gerber, its golf bag is constructed to maximize storage capacity and portability of a golf bag, not to facilitate the attachment of indicia thereto. In accordance with the original Specification of the subject Application (See Page 3), it is clear that the disclosed construction of any dual-walled pockets, including those disclosed in Gerber, is not conducive to the attachment of indicia by sewing or embroidery because this construction is quite difficult to embroider and/or sew intricate patterns therein. In light of the fact that the claimed invention differs structurally from the golf bag disclosed in Gerber and solves a problem not recognized by Gerber, the claimed invention could not have been obvious let alone anticipated by Gerber. Thus, Applicants respectfully request the Examiner to withdraw his § 102(b) rejection.

In further distinguishing the structure of the present invention from the golf bag of Gerber, Applicants have amended claim 3 to claim that the carrying strap is positioned diametrically opposite the single-walled panel member. Such construction is contrary to the teachings of Gerber as shown in **Figure 3** of that cited art reference.

Dependent claims 6 and 8 were rejected under 35 U.S.C. § 103 as being unpatentable over Gerber in view of U.S. Patent No. 5,222,598 to Yamazoe. More particularly, the Examiner contends that Gerber discloses the claimed invention except for the use of water resistant and padded material which is taught in **Figure 5** of Yamazoe. Besides traversing this contention on the above-cited grounds pertaining to independent claims 1 and 7, Applicants further submit that neither Gerber nor Yamazoe teaches or suggests incorporating a second mating securing portion around a periphery of the single-walled panel being completely removable from and connected to a first mating securing portion fixedly attached to the golf bag as is claimed in claim 4 from which claim 6 indirectly depends and in claim 8 itself. Therefore, Applicants respectfully request the Examiner to withdraw his § 103 rejection pertaining to claims 6 and 8.

Dependent claims 9 and 10 were rejected under 35 U.S.C. § 103 as being unpatentable over Gerber in view of U.S. Patent No. 3,061,057 to Miller. Miller is not relevant to embroidery and sewing difficulties associated with golf bags. Although Miller does disclose a zipper around a periphery of a supplemental side luggage unit 20, it does not invent a single-walled panel for the purpose disclosed and claimed in independent claim 7 from which claims 9 and 10 depend. There is no suggestion in Gerber or Miller to combine the teachings and clearly, neither device was attempting to solve the problem overcome by Applicants' claimed invention. It appears that combination of Gerber and Miller is a clear case of impermissible hindsight reconstruction and should not preclude Applicants from obtaining patent protection of the claimed invention. Therefore, Applicants respectfully request the Examiner to withdraw his § 103 rejection pertaining to claims 9 and 10.

